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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,559	11/21/2003	John A. Underwood	200300317-2	3548

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

CHAU, MINH H

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/719,559

Applicant(s)

UNDERWOOD ET AL.

Examiner

Minh H. Chau

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-44 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 and 26-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 10, 12-14 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8 and 25 is/are rejected.
- 7) ☒ Claim(s) 6 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. **Claim 12** is objected to because of the following informalities: The dependency of claim 12 is improper because claim 11 has been canceled by the Amendment filed on 08/14/06. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4, 7, 8 and 25** are rejected under 35 U.S.C. 102(b) as being anticipated by *Inoue et al.* (US # 3,835,297).

With respect to **independent claim 1**, *Inoue et al.* teach a method for using color index code marks or eye marks (6), comprising providing with a printing device (cols. 6-7) an eye mark (Figs. 3 & 4) having at least two sections arranged along a longitudinal axis (Fig. 4), wherein each section includes a border common to both sections (Fig. 4) and a unique characteristic relative to other sections (col. 3, lines 54-63) and encoding instructions in the eye mark based upon the combination of the at least two sections (col. 4, lines 1-8 and cols. 7-9), the types of information (instructions) of microfilm is being determining or encoding based on the number or the combination of code marks in the color index code.

With respect to **claim 2**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing color index code marks or an eye mark (6) having at least two sections further include providing the unique characteristic of each section of the eye mark as a first and a second color characteristic.

With respect to **claim 3**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing the unique characteristic of each section of the eye mark as the first and the second color characteristic includes an eye mark having the first and the second color characteristic selected from the colors cyan, magenta, yellow, black, light cyan, light magenta, red, green, and blue.

With respect to **claim 4**, see Fig. 4 and col. 3, lines 54-63 of *Inoue et al.* that teach a method of providing an eye mark having at least two sections includes providing an eye mark having more than two unique color characteristics.

With respect to **claim 7**, see Figs. 3 and 4 of *Inoue et al.* that show an eye mark (6) having at least two sections includes providing an eye mark having a first and a second shape characteristic for the at least two sections.

With respect to **claim 8**, wherein providing an eye mark (6) having a first and a second shape characteristic includes providing a first and a second shape characteristic which are different from one another.

With respect to **independent claim 25**, *Inoue et al.* teach a computer readable medium having a set of computer executable instructions to cause a device to perform for using color index code marks or eye marks (Figs. 3 & 4), comprising providing an eye mark with a printing device (cols. 6-7) on microfilm or a print media (Fig. 4 & col. 3),

having at least two color sections positioned along a longitudinal axis for parallel sensing (Fig. 4), wherein each color section includes a border common to both sections and includes a different color characteristic relative other color sections (Fig. 4 and col. 3, lines 54-63), and encoding instructions in the eye mark based on the different color characteristics (col. 4, lines 1-8 and cols. 7-9), the types of information (instructions) of microfilm is being determining or encoding based on the number color code marks in the color index code.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over ***Inoue et al.*** as applied to claims 1-4, 7, 8 and 25.

With respect to **claim 5**, ***Inoue et al.*** teach the limitation as explained in the rejection above, except for an eye mark having a white characteristic section.

Inoue et al. teach an eye mark having at least two sections including an eye mark having a black characteristic and a color characteristic for the at least two sections (Fig. 4 and col. 9, lines 2-10); ***Inoue et al.*** also discuss the use of an eye mark having a white characteristic section by the prior art (col. 9, lines 6-10).

In view of this teaching, it would have been obvious to one of skill in the art to modify the method for using eye mark of *Inoue et al.* to including an eye mark having a white color characteristic section as taught by the prior art as mentioned in the *Inoue's* reference so that a variety difference colors can be use in eye mark thus provides information encode in eye mark can be increased.

Allowable Subject Matter

6. **Claims 6, 9** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10, 12-14 and 24 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

Claim 6 has been indicated for containing allowable subject matter because the combination of a method for using eye mark including the step of providing an eye mark having at least two sections includes providing an eye mark having a color characteristic and a location characteristic for the at least two sections could not be found in the prior art of record.

Claim 9 has been indicated for containing allowable subject matter because the combination of a method for using eye mark including the step of providing an eye mark having at least two sections includes providing a first and a second characteristic for the at least two sections that have at least a three bit binary structure could not be found in the prior art of record.

Claims 10 and 12-14 have been indicated for allowance because the prior art fails to teach the combination of a method for using an eye mark including encoding instruction in the eye mark based on the different color characteristics and the encoded instructions further include a processing instruction.

Claim 24 has been indicated for allowance because the prior art fails to teach the combination a computer readable medium having a set of computer executable instruction to cause a device to perform a method including encoding instruction in the eye mark based upon the combination of the at least two sections and the encoded instructions further include a processing instruction.

Response to Arguments

8. Applicant's arguments filed on August 14, 2006 have been fully considered but they are not persuasive.

With respect to the rejection of claims 1-4, 7, 8 and 25 under 35 USC 102(b), the Applicant's argument center around that the *Inoue* reference "*does not show providing with a printing device and eye mark ...*". The Examiner respectfully disagrees with the Applicant's opinion because as discussed in cols. 6-7 the *Inoue* reference does teach a method of providing *with a printing device* an eye marks (Figs. 3-4) having at least two sections arranged along a longitudinal axis (Fig. 4).

With respect to the rejection of claim 5 under 35 USC 103(a), the Applicant does not provided any specific argument for this claim, therefore claim 5 is stand or fails with the independent claim 1.

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh H. Chau whose telephone number is (571) 272-2156. The examiner can normally be reached on M - TH 9:30AM - 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHC
November 13, 2006


MINH CHAU
PRIMARY EXAMINER